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No. 1338

In the

Supreme Court of the United States

OCTOBER TERM, 1965.

AUTOMATIC ELECTRIC COMPANY,

Petitioner,

vs.

TECHNOGRAPH PRINTED CIRCUITS, LTD., and TECHNOGRAPH PRINTED ELECTRONICS, INCORPORATED,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

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The Scheffer Press, Inc.—ANdover 3-6850

INDEX

	PAGE
Opinions Below	1
Jurisdiction	2
Questions Presented	2
Introductory Statement	3
Statutes Involved	4
Statement of the Case	4
Reasons for Granting Petition	8
I. On the Broad Principle of the Relief Afforded by an Adjudication of Patent Invalidity	8
II. As to the Substantive Issues	14
1. Relieving The Public of an Asserted Monopoly	14
2. The Procedure in a Second Suit on Patents Held Invalid	16
Conclusion	16
Appendix A	1a
Appendix B	15a
Appendix C	16a
Appendix D	17a
Appendix E	19a

AUTHORITIES CITED

Aghnides v. Holden, 226 F.2d 949 (7 Cir. 1955) 8, 10

Bernhard v. Bank of America, 19 Cal. 2d 807, 122 P.2d 892 (1942) 12, 13

PAGE

Bruszewski v. United States, 181 F.2d 419 (3 Cir. 1950) 12

Factor v. Pennington Press, Inc., 230 F.Supp. 906 (N.D. Ill. 1963) 12, 13

Haughey v. Lee, 151 U.S. 282 (1894) 8, 13, 14, 15

Kellogg Switchboard & Supply Co. v. Michigan Bell Telephone Co., 99 F.2d 203 (6 Cir. 1938) 13

Lovell Manufacturing Co. v. Cary, 147 U.S. 623 (1893) 15

McCandless v. Furlaud, 296 U.S. 140 (1935) 11

Mast, Foos & Co. v. Stover Mfg. Co., 177 U.S. 485 (1900) 3

Maytag Co. v. Hurley Co., 307 U.S. 243 (1939) 3

Miller v. Foree, 116 U.S. 22 (1885) 15

Nickerson v. Pep Boys—Manny, Moe & Jack, 247 F. Supp. 221 (D. Del. 1965) 14

Paramount Publix Corp. v. American Tri-Ergon Corp., 294 U.S. 464 (1935) 13, 14

Sanitary Refrigerator Co. v. Winters, 280 U.S. 30 (1929) 3

Technograph Printed Circuits, Ltd. v. Bendix Aviation Corp., 218 F. Supp. 1 (D. Md. 1963); Affirmed 327 F. 2d 497 ..... 5, 15

Triplett v. Lowell, 297 U.S. 638 (1936) 2, 9

United Air Lines, Inc. v. Wiener, 335 F.2d 379 (9 Cir. 1964) 12

United States v. American Bell Telephone Co., 128 U.S. 315 (1888) 13

Upshaw v. United States, 335 U.S. 410 (1948) 11

PAGE

Williams v. United Shoe Mach. Corp., 121 F.2d 273 (6 Cir. 1941) 13

Zdanok v. Glidden Company, 327 F.2d 944 (2 Cir. 1964) 12

28 U.S.C. § 1254 (1) 2

28 U.S.C. §§ 1338 & 1400(b) 5

35 U.S.C. § 102 4

35 U.S.C. § 102(b) 5

35 U.S.C. § 103 ..... 4, 5

Rule 52 FRCP 4

Rule 52(a) FRCP 6

Rule 56 FRCP 4, 6

"Civil Procedure: The Tempest Brews," by Brainerd Currie in California Law Review, Vol. 53, No. 25, pp. 38-46 4

"Mutuality of Collateral Estoppel: Limits of the Bernhard Doctrine," Stanford Law Review, Vol. 9, pp. 281-322, 1957 4

"Bentham, Rationale of Judicial Evidence, in Works of Jeremy Bentham 171" (Bowring Ed. 1843) 11

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vs.

GENERAL TELEPHONE & ELECTRONICS CORPORATION

and

AUTOMATIC ELECTRIC COMPANY,

Petitioner.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

Petitioner, Automatic Electric Company, respectfully petitions for a writ of certiorari to the United States Court of Appeals for the Seventh Circuit.

OPINIONS BELOW.

The opinion of the Court of Appeals (Appendix A, *infra,* pp. 1a-14a) is reported at 356 F.2d 442.

The District Court for the Northern District of Illinois entered an order granting a motion for summary judg-

ment based upon the invalidity of the patents in suit. It is not reported but is set forth in substance in petitioner's appendix (P.A. p. 4)[1] and in the Court's opinion below (Appendix A, *infra,* p. 3a).

JURISDICTION.

The judgment of the Court of Appeals was entered on January 7, 1966 (Appendix B, *infra,* p. 15a). A petition for rehearing was denied on March 22, 1966 (Appendix C, *infra,* p. 16a). The mandate of the Court of Appeals has been stayed until June 2, 1966 to permit the filing of this petition (Appendix D, *infra,* pp. 17a, 18a).

The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

QUESTIONS PRESENTED.

As to Readjudication of Patents Held Invalid:

1. Where *Triplett* v. *Lowell,* 297 U.S. 638, 642 (1936) holds that an adjudication adverse to the patent does not preclude another suit upon the same patent against another defendant;

a) on what theory of law or logic and under what conditions should the patentee be entitled to a second full trial including testimony on the merits involving precisely the same issues of law and fact upon which the patentee has had a day in court; and

b) if *Triplett* compels such a second full trial, should not this court now review and clarify that

[1] References to petitioner's appendix below entitled "APPENDIX TO APPELLEE'S BRIEF" will be designated (P.A. .....), and respondent's appendix below entitled "APPENDIX TO APPELLANT'S BRIEF" as (R. A. .....).

decision and provide much needed guidance and authority in the patent field consistent with the need to exonerate and free the public of the harassment of endless litigation.

As to the Merits of This Case:

2. Where the patents (Eisler patents Nos. Re. 24,165 and 2,706,697) previously have been held invalid in view of specified prior art in an affirmed decision where certiorari was denied, did not the District Court in this second suit on the same patents apply the proper criteria in requiring the respondent to show cause why the matter should not be disposed of without the necessity of a complete trial and in granting summary judgment based upon substantially the same specified prior art.

INTRODUCTORY STATEMENT.

The "doctrine" of *Triplett* is, of course, well known and its misapplication is no doubt responsible for much of the complexity, cost, indecisiveness and dissatisfaction associated with patent litigation. The decision is over thirty years old and has stood, singlehanded, for the proposition that a patentee whose patent is adjudged invalid in one suit, is not bound by that adjudication against the rest of the world but can relitigate again and again.[2] The doctrine grew out of the broader doctrine of mutuality of estoppel which is being rapidly eroded and

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[2] In the cited precedents, *Mast, Foos & Co.* v. *Stover Mfg. Co.*, 177 U.S. 485 (1900) and *Sanitary Refrigerator Co.* v. *Winters*, 280 U.S. 30, 35 (1929), the patent had been first held valid. In only one case this Court has referred to the *Triplett* case, *Maytag Company* v. *Hurley Machine Co. et al.*, 307 U.S. 243, 244 (1939) and there for the proposition that a claim that should have been disclaimed might have been the basis of another suit.

recognized as illogical and unjust.[3] While in other fields the doctrine can evolve through many courts, in the patent field it remains for this Court to provide the much needed authority. This case provides an ideal opportunity for this Court, by granting certiorari, to clarify the doctrine and bring the concepts of collateral estoppel and comity in patent cases abreast of the demands of modern practice and the law in other fields and into consonance with the actual holding in *Triplett*.

STATUTES INVOLVED.

The provisions of Rules 52 and 56, Federal Rules of Civil Procedure, and of Sections 102 and 103 of the Patent Code of 1952 (35 U.S.C. §§ 102 and 103) are relevant and are reproduced in Appendix E.

STATEMENT OF THE CASE.

The respondents are the owner and exclusive licensee, respectively, of the two patents in suit, U. S. Patent Nos. Re. 24,165 and 2,706,697 which resulted from a single parent application (Appendix A, p. 2a). The patents relate to a method of manufacturing electric circuit components by etching away selected portions of a copper foil from an insulating base and include no claims directed to the components *per se*.[4]

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[3] Mutuality of estoppel has been rejected in at least three federal circuits and in many district and state courts. A rather complete summary of the cases is appended to the article "Civil Procedure: The Tempest Brews" by Brainerd Currie in *California Law Review*, Vol. 53, No. 25, pp. 38-46. Also of interest is Currie, "Mutuality of Collateral Estoppel: Limits of the Bernhard Doctrine" *Stanford Law Review*, Vol. 9, pp. 281-322, 1957.

[4] The patents are set out in full at R.A. 51a et seq. The essence of the methods is described in Patent Re. 24,165 at col. 1, 11. 51-54, 63-72, col. 2, 11. 1-8 and col. 5, 11. 65-75 and in Patent 2,706,697 at col. 1, 11. 45-48, 57-75 and col. 5, 11. 20-41 and 60-70.

The basis of federal jurisdiction in the District Court was 28 U.S.C. §§ 1338 and 1400 (b).

Respondents filed approximately eighty civil actions based upon various combinations of the two patents here in suit plus a third one, U. S. Patent No. 2,441,960, which was also based upon the same parent application. Patents Nos. 2,441,960 and Re. 24,165 have expired.

One of these eighty suits, the action against Bendix Aviation Corp. in Maryland was tried first.[5] The trial was extensive and thorough as evidenced by the comprehensive opinion of Judge Watkins extending from pages 1 through 67 of 218 F. Supp. Respondents had a full, free and unfettered opportunity to defend the validity of the patents and after full briefing and argument, the District Court held the claims of the three Eisler patents in suit invalid as anticipated by a Stevens and Dallas reference under 35 U.S.C. 102(b). The court also held "Should another court find that the alleged Eisler inventions were not identically disclosed or described in the Stevens and Dallas application, this court unhesitatingly finds and holds that 'the differences between the subject matter sought to be patented and the prior art'' were ''such that the subject matter as a whole would have been obvious at the time the [alleged] invention[s] [were] made to a person having ordinary skill in the art to which said subject matter pertains' ". (35 U.S.C. § 103, 218 F. Supp. 1, 31).

The Fourth Circuit Court of Appeals specifically affirmed per curiam on the latter basis on January 17, 1964 (327 F.2d 497, 1964). On June 12, 1964 petitioner in the

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[5] *Technograph Printed Circuits, Ltd.* v. *Bendix Aviation Corp.*, 218 F. Supp. 1 (D. Md. 1963), affirmed 327 F.2d 497 (4 Cir. 1964), Cert. Den. 379 U.S. 826 (1964). Footnote 21 at 218 F. Supp. 1, 8 describes the extent of the proceedings.

case at bar moved the District Court for summary judgment of patent invalidity based upon much of the same prior art relied upon and discussed in detail in the *Bendix* decision.[6] All briefs were submitted by October 18, 1964 and petitioner's motion was granted on December 30, 1964. Respondents filed six affidavits at various times during the six month period in which the motion was pending.[7] None raised any factual issue, none supported any contention that the methods of the prior art were not precisely the methods of the Eisler patents, and none supported any contention that plaintiff did not have a full opportunity to present its case on the prior art before the Maryland Court or that the Maryland Court was clearly in error.

The only substantive allegations about the prior art were in the Town affidavit but these were perfunctory and went to the nature of the *unpatented devices* made by the methods of the prior art and not to the patented methods at all. (R. A. 32-34a). Respondents' brief gave only lip service to the entire subject.[8] Petitioner placed substantial reliance upon the *Bendix* decision and respondents failed to meet their burden of showing prima facie that this decision was clearly in error. Thus the District Court granted petitioner's Motion on December 30, 1964 without an opinion or formal findings of fact or conclusions of law.[9]

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[6] On that same day respondent here petitioned this Court for a Writ of Certiorari to the Fourth Circuit in the *Bendix* case.

[7] R.A. pp. 12a-50a.

[8] The major portion of respondents' treatment of the prior art is set forth in petitioner's Appendix (P. A. pp. 32a-33a).

[9] Findings of fact would be out of place in summary judgment proceedings. Rule 52(a) specifically excludes proceedings under Rule 56 from the requirement for findings of fact and conclusions of law.

The Seventh Circuit Court of Appeals, in reversing and remanding for the taking of testimony at a trial on the merits relied in part upon the *Bendix* decision for a detailed description of the patent claims (Appendix A, p. 13a). The Court quoted the District Court extensively in showing why there was little doubt in the court's mind that the District Court thought "that the Maryland decision in *Bendix* settled the matter" (Appendix A, p. 5a). The Court of Appeals summarized the six affidavits filed by respondents and these summaries show clearly that no *fact* issue was raised, no showing is made which was not made in the *Bendix* decision, and no showing is made evidencing any clear error in *Bendix* (Appendix A, pp. 6a-8a). The Court stated that the prior art patents escape their understanding but appeared to find error in the District Court's judgment solely because of the lengthy decision in *Bendix* (Appendix A, p. 13a).

Instead of placing reliance upon the comprehensive *Bendix* decision holding the same patents invalid in view of the same prior art, and giving that decision great weight, the court observed that the *Bendix* opinion indicates a sharp and bitter dispute concerning the factual determinations (Appendix A, p. 10a). The Court thus rejected the prior adjudication and stated that having the *Bendix* opinion before them is a far cry from having before them the record of the testimony in that case (Appendix A, p. 10a).

Instead of placing the burden on respondents to make a prima facie showing that they could prove that the *Bendix* decision was clearly wrong or that respondents had not had a full opportunity to meet the prior art, the Court of Appeals held that all inferences must be viewed in the light most favorable to the respondents and that all doubts must be resolved against petitioner and con-

sequently against the correctness of the *Bendix* decision (Appendix A, p. 9a).

The Court of Appeals viewed this case as though the patents had not already been held invalid in the *Bendix* decision, or even worse, used the comprehensive and thorough *Bendix* decision to infer that because of that decision there must be genuine issues presented by petitioner's motion and thus the District Court erred in granting summary judgment. The Court also made a considerable point of the District Court's reliance on the *Bendix* decision and appears to have reversed because of this without seriously considering the contentions on the merits.

It has been petitioner's position at all times that this action was not *barred* by any aspect of *res judicata* but that, following *Triplett*, the *Bendix* decision should be given great weight and should be followed if the court found that the issues of law and fact are the same. The Court of Appeals has not held that the issues of law and fact are different.

Respondents contended, and the Court of Appeals apparently agreed, that *Triplett* and *Aghnides* v. *Holden*, 226 F.2d 949 (7 Cir. 1955) require that where there is a prior adjudication of invalidity, no weight can be given to that decision until, in each subsequent case, full testimony has been taken at a trial on the merits and the Court has made its independent determination.

REASONS FOR GRANTING PETITION.

I. On the Broad Principle of the Relief Afforded by an Adjudication of Patent Invalidity.

There is a very substantial public interest involved in the issue of patent validity.[10] An extant patent, invali-

[10] *Haughey* v. *Lee*, 151 U.S. 282, 285 (1894).

dated by court decree, but "enforceable" under the present interpretation of *Triplett* through the harassment of protracted trials, is a *de facto* denial of a public relief which the courts are empowered and bound to declare.

The courts have the right, power and duty to follow and implement a first decision in any appropriate summary proceeding without a requirement that testimony be taken in successive trials on the merits unless the patentee was denied a full trial or there was clear error in the first adjudication.

The requirement of the taking of testimony at a trial before comity can apply is a clear misinterpretation of *Triplett*. This Court held only that the prior adjudication could not act as a *bar* to the bringing of a second action against a different defendant not in privity with the first. This Court in *Triplett* (No. 590) effectively stated that whether the second litigation is in the same circuit or a different one is immaterial; the court should look at the issues of fact and law in the second case. If they are the same as in the first case, only then is the second court bound to follow the first.[11]

Thus from *Triplett* itself a standard for the "great weight" to be given to the prior decision is also established.

This Court should now consider the construction which has been placed on *Triplett* and take this opportunity to clarify the law and implement the administration of justice in the patent field. In particular, the Seventh

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[11] The decision actually states the negative of this proposition, ". . . the court must decide whether the issues of law and fact in the two cases are the same, and if they are not it is not bound by the earlier decision." 297 U.S. 638, 648.

Circuit Court of Appeals has read into *Triplett* an absolute requirement for a trial with testimony on the merits before the earlier decision can become the law of the case. *Aghnides* v. *Holden,* 226 F.2d 949 (7 Cir. 1955).[12] A concurring opinion recognized the unfortunate consequences of this interpretation of *Triplett* but thought the matter required legislative correction.[13] Such is not the case. All that is required is judicial clarification by this Court. A statement of what *Triplett* stands for and how that case applies in summary proceedings is crucial in the circumstances. Where, as here, a decision of this Court has been misconstrued and misapplied, it is im-

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[12] The court in *Aghnides* v. *Holden* stated: "Plaintiffs have a right, if they desire, to litigate as against other defendants and not until and unless it appears by the evidence submitted at the trial that it does not differ essentially from the evidence submitted in the former case, will the decision in the first case become the law of the present one." (226 F.2d 949, 950)

[13] Judge Schnackenberg concurred but stated that *Aghnides* was entitled to a second full trial even without any affidavit showing. "The law does not require him to justify this indulgence. He is entitled to it because a suit testing the validity of a patent is not a proceeding *in rem* and hence Aghnides may litigate and relitigate again and again the question of validity of his patent as long as he selects a different defendant in each of the infringement suits which he files, thus avoiding the wholesome doctrine of *res adjudicata.* This queer result is one which we are unable to avoid. It is a situation which is particularly abhorrent when considered against the backlog of untried cases which clogs our federal courts. The latter are cases where the litigant asks only for his day in court, not a plurality of days in court as Aghnides is entitled to under the existing law. The remedy lies not in our hands. The congress could by legislation grant relief." (226 F.2d 949, 951)

portant that this Court grant certiorari to provide the much needed corrective authority. *McCandless* v. *Furland*, 296 U.S. 140 (1935), *Upshaw* v. *United States*, 335 U.S. 410 (1948).

How did the present view of *Triplett* come into existence? It is the result of an excessively zealous application of the "curious" rule of mutuality of estoppel that, as a judgment is not evidence *against* a stranger, the contrary judgment shall not be evidence *for* him.[14]

Because of the unique nature of the patent law as a purely federal body of law it is necessary and crucial that this court protect the second, third and eightieth defendants as well as the public generally from the present interpretation of *Triplett*.

In other fields of law the doctrine of mutuality of estoppel has been eroding for more than twenty years. Chief Justice Traynor, one of the nation's outstanding jurists and legal scholars, speaking for the Supreme Court of California, appears to have led in the recognition of a second defendant's right to hold a plaintiff to the factual determinations in an earlier decision although the

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[14] From "Bentham, Rationale of Judicial Evidence, in 7 Works of Jeremy Bentham 171" (Bowring Ed. 1843) which went on to state: "If the rule itself is a curious one, the reason given for it is still more so: . . . 'Nobody can take benefit by a verdict, who had not been prejudiced by it, had it gone contrary:' a maxim which one would suppose to have found its way from the gaming-table to the bench. * * * There is reason for saying that a man shall not lose his cause in consequence of the verdict given in a former proceeding to which he was not a party; but there is no reason whatever for saying that he shall not lose his cause in consequence of the verdict in a proceeding to which he *was* a party, merely because his adversary was not."

second defendant was not in any way a party to the first case.[15]

Unilateral estoppel has been followed in the Ninth Circuit in a personal injury case, *United Air Lines, Inc.* v. *Wiener,* 335 F.2d 379 (9 Cir. 1964) in the Second Circuit in a collective bargaining dispute, *Olga Zdanok et al.* v. *The Glidden Company,* 327 F.2d 944 (2 Cir., 1964), Cert. Den. 377 U.S. 934, where it was recognized "that such a holding would have seemed impossible fifty years ago," and in the Third Circuit in an admiralty case, *Bruszewski* v. *United States,* 181 F.2d 419-421 (3 Cir. 1950), Cert. Den. 340 U.S. 865.[16]

The law in the Seventh Circuit in other than patent cases may be the same. In *Factor* v. *Pennington Press, Inc.,* 230 F.Supp. 906, 910 (N.D. Ill. E.D. 1963), the court

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[15] In *Bernhard* v. *Bank of America,* 19 Cal. 2d 807, 122 P.2d 892 (1942), the Court stated: "No satisfactory rationalization has been advanced for the requirement of mutuality. Just why a party who was not bound by a previous action should be precluded from asserting it as *res judicata* against a party who was bound by it is difficult to comprehend. . . ."

[16] When *Bruszewski* attempted to prove negligence of the steamship company in a second case against the government, the Second Circuit Court stated: "The finding of no negligence on the other hand was made after full opportunity to *Bruszewski* on his own election to prove the very matter which he now urges a second time. Thus, no unfairness results here from estoppel which is not mutual. In reality the argument of appellant is merely that the application of *res judicata* in this case makes the law asymmetrical. But the achievement of substantial justice rather than symmetry is the measure of the fairness of the rules of *res judicata.*"

reiterated the three requirements of the *Bernhard* case to foreclose relitigation of an issue.[17]

The construction placed upon *Triplett* whereby a second full trial on the merits is always necessary reduces the prior adjudication to nothing, or perhaps to some small make-weight in the judicial process.

It appears that historically it was contemplated that the United States might bring actions in the public interest to void patents and thus eliminate harassing litigation, *United States* v. *Bell Telephone Co.*, 128 U.S. 315 (1888), but this provides no protection for the public today. "The public . . . is always impliedly . . . a third party to an infringement suit." *Williams* v. *United Shoe Mach. Corp.*, 121 F.2d 273 (6 Cir. 1941), affirmed 316 U.S. 364. "Besides, the defense of want of patentable invention in a patent operates not merely to exonerate the defendant, *but to relieve the public from an asserted monopoly*" (emphasis added) *Haughey* v. *Lee*, 151 U.S. 282, 285 (1894).[18]

This Court's supervisory authority is needed *now* and this case provides the logical and immediate vehicle to

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[17] 1, the issue must be identical; 2, the prior judgment must be final; and 3, "The party *against whom* the prior determination is asserted to be *res judicata* must have been a party, or in privity with a party, to the prior adjudication so that he had full opportunity to litigate the issue at least once. (However, there is no requirement of 'mutuality of privity': the party *who asserts* the prior determination as *res judicata* does not need to have been a party, or in privity with a party, to the prior adjudication." 230 F.Supp. 906, 910

[18] To the same effect are *Paramount Publix Corp.* v. *American Tri Ergon Corp.*, 294 U.S. 464, 477 (1935); *Kellogg Switchboard and Supply Co.* v. *Michigan Bell Telephone Co.*, 99 F.2d, 203, 205 (6 Cir. 1938).

provide the relief referred to in the *Haughey* case. The harbinger of things to come is *Nickerson* v. *Pep Boys—Manny, Moe & Jack,* 247 F. Supp. 221 (D.Del., 1965), where the court stated that "From the standpoint of precedents, *Triplett* v. *Lowell* does not rest upon too solid a foundation" and granted defendant's Motion for Summary Judgment based solely upon a prior adjudication of invalidity to which the defendant was not a party. A petition for certiorari raising the same issue has been filed in *Technograph et al.* v. *Croname, Inc.* and is now pending as No. 1187 in the October 1965 term.

In several recent cases this Court has clarified the standard of "invention" required to sustain a patent. The pressing need now is for a clarified procedure "relieving * * * the public from the asserted monopoly when there is no invention." [19]

II. As to the Substantive Issues:

1. Relieving The Public of an Asserted Monopoly.

Respondents' two patents relate to certain methods of making electric circuit components by etching away metal foil. The 80 civil actions initiated throughout the country based in part on these patents are an onerous public burden which should be lifted as soon as possible. The methods of the patents involve only the formation of an etch resistant pattern in either metal or non-metal on a conductive foil and removing the unprotected foil. These methods were notoriously old and *Bendix* held the patent claims invalid on this ground. Now the public should be exonerated; relieved of the asserted monopoly.[20] But such result is not clear in view of *Triplett.*

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[19] *Paramount Publix Corp.* v. *American Tri-Ergon Corp.,* 294 U. S. 464, 477 (1935).

[20] *Haughey* v. *Lee,* 151 U. S. 282, 285 (1894).

Petitioner's Motion for summary judgment relied upon various prior art disclosures and particularly upon the Stevens and Dallas disclosure of a completely anticipatory method (P. A. 17a, 21a-31a). The court had found such anticipation in *Bendix* (218 F. Supp. 1, 31). The District Court so found in this case in granting petitioner's motion. The respondents never disputed anticipation of the method, but by the only affidavit containing any relevant factual assertion alleged that the *unpatented device* resulting from the practice of the method was different, an issue that had been disposed of in *Bendix*.[21] Any difference between the devices has no bearing on the method claims relating to an etching process.

It is a fundamental principle "that it is not a patentable invention to apply old and well known devices and processes to new uses, in other and analogous arts."[22] Any differences in the devices here are merely in their shape, not in their nature. They are all "electrical components". These are the findings in *Bendix*, 218 F. Supp. 1, 41-42. Respondents have neither done nor said anything which would entitle them to a readjudication of this issue.

Unless petitioner and the remaining defendants throughout the country can place reliance upon the adjudication of invalidity, the expressed intent of *Hughey* v. *Lee*, 151 U.S. 282, and a vast body of law is frustrated.

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[21] The affidavits of *Jolly*, (R. A. p. 12a), *Pitzer*, (R. A. p. 48a) and *Shortt* (R. A. p. 23a) include no relevant allegations, the affidavits of *Everitt*, (R. A. p. 37a) and *Williams*, (R. A. p. 14a) are pure legal conclusions while the affidavit of *Town* (R. A. 26a) devotes three lines to Stevens and Dallas, alleging a difference in the devices.

[22] *Lovell Mfg. Co.* v. *Cary*, 147 U.S. 623, 637 (1893); *Miller* v. *Foree*, 116 U.S. 22, 27-28 (1885).

2. The Procedure in a Second Suit On Patents Held Invalid.

The Court of Appeals treated this case like any other motion for summary judgment, or worse, utilized the prior adjudication to increase defendant's burden.[23] This was the result of a basic misapplication of the law in *Triplett* indicating a need for a restatement thereof.

The Court of Appeals construed the thorough and decisive opinion in *Bendix* as *creating* instead of *resolving* issues. This, too, was the result of an error in construing *Triplett* indicating a need for restatement thereof.[24]

The Court of Appeals found that it was "left in the dark concerning the District Court's reasons for granting summary judgment."[25] This, too, resulted from a refusal to give weight or credence to *Bendix* and was contrary to sound legal principles and what *Triplett* should stand for.

The Court of Appeals concluded that the District Court thought "that the Maryland decision in *Bendix* settled the matter."[26] This shows further that the court reacted negatively to any reliance upon the prior adjudication which is contrary to the proper rule of law and the intent of *Triplett*.

CONCLUSION.

For the reasons stated, this Petition for Certiorari should be granted.

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[23] 356 F.2d 442, 447 (Appendix A, p. 9a).
[24] 356 F.2d 442, 447 (Appendix A, p. 10a).
[25] 356 F.2d 442, 446 (Appendix A, p. 8a).
[26] 356 F.2d 442, 445 (Appendix A, p. 5a).